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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/992,036	11/23/2001	Michael D. Dahlin	1039-0040	4450
34456 7590 06/04/2010 LARSON NEWMAN & ABEL, LLP 5914 WEST COURTYARD DRIVE SUITE 200 AUSTIN, TX 78730				
EXAMINER				
PASS, NATALIE				
ART UNIT		PAPER NUMBER		
3686				
MAIL DATE		DELIVERY MODE		
06/04/2010		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

09/92,036

**Applicant(s)**

DAHLIN ET AL.

**Examiner**

Natalie A. Pass

**Art Unit**

3686

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 February 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 9-11, 16-20, 25-31, 40-44 and 51-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-11, 16-20, 25-31, 40-44 and 51-53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Notice to Applicant***

1. This communication is in response to the amendment filed 16 February 2010. Claims 9, 18, 43-44, and 53 have been amended. Claims 1-8, 12-15, 21-24, 32-39, and 45-50 have been previously cancelled. Grounds of rejection for claims 9-11, 16-20, 25-31, 40-44 and 51-53 are set forth in detail below.

### ***Claim Rejections - 35 USC § 101***

2. The rejection of claims 9-11, 16-17, 27-31, 40-44, 51 and 53 under 35 U.S.C. §101 is hereby withdrawn due to the amendment filed 16 February 2010.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 9-11, 16-20, 25-31, 40-44, and 51-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lewis et al., U.S. Patent Application Publication No. 2001/0041992 (it should be noted that the Examiner is relying on the priority date from the Lewis parent application 09/523,569; based on review of the parent application it is believed that the portions of the child

application cited below are fully supported by the parent application), and Yoder, J. et al., The MEDIGATE Graphical User Interface for Entry of Physical Findings: Design Principles and Implementation. Journal of Medical Systems. Vol. 22, No. 5 / October, 1998, pages 325-337. URL: <<http://www.springerlink.com/content/g8504238744271h2/fulltext.pdf>>, hereinafter known as Medigate, for substantially the same reasons given in the previous Office Action (paper number 20090910). Further reasons appear hereinbelow.

- (A) Claims 9 and 53 have been amended to recite:
- “interface device” throughout the body of the claims.

As per these new limitations, Lewis and Medigate teach a method as analyzed and discussed in the previous Office Action (paper number 20090910) further comprising displaying on and interacting with a user via an interface device (Lewis; Figure 3A, Figure 3B, paragraphs [0007], [0033]).

As per the remaining amendments to claims 9 and 53, these appear to have been made merely to correct errors in the claim language. While these changes render the language of the claim smoother and more consistent, they otherwise affect neither the scope and breadth of the claim as originally presented nor the manner in which the claim was interpreted by the Examiner when applying prior art within the previous Office Action. As such, the remainder of claims 9 and 53 is rejected for the same reasons given in the prior Office Action (paper number 20090910, section 6, pages 4-13), and incorporated herein.

The motivations to combine the respective teachings of Lewis and Medigate are as discussed in claim 9 of the previous Office Action (paper number 20090910), and incorporated herein.

(B) As per the amendments to claim 18, these appear to have been made merely to correct errors in the claim language. While these changes render the language of the claim smoother and more consistent, they otherwise affect neither the scope and breadth of the claim as originally presented nor the manner in which the claim was interpreted by the Examiner when applying prior art within the previous Office Action.

As such, the recited claimed features are rejected for the same reasons given in the prior Office Action (paper number 20090910, section 6, pages 4-13), and incorporated herein.

(C) Amended claims 43-44 recite substantially similar limitations to amended method claim 9 and, as such, are rejected for similar reasons as given above.

(D) Claims 10-11, 16-17, 19-20, 25-31, 40-42, and 51-52 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 20090910, section 6, pages 4-13), and incorporated herein.

### ***Response to Arguments***

5. Applicant's arguments filed 16 February 2010 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 16 February 2010.

(A) As per Applicant's arguments in paragraph 4 of page 8 of the response filed 16 February 2010 that "Lewis and Yoder [Examiner interprets 'Yoder' to refer to the Medigate reference] fail to teach or suggest a tri-state control to indicate one of three states," Examiner respectfully disagrees. Examiner interprets Medigate's teachings of allowing the physician to utilize the letters:

(1) "N" to designate the "Normal" state, and

(2) "P" to denote the problem areas state, and

(3) "X" to designate a positive affirmation state that all the findings were checked

(Medigate; pages 330, paragraph 2 to page 332, paragraph 1), to teach a form of a "tri-state control" to indicate one of three states.

As per Applicant's arguments in the paragraph bridging pages 9-10 of the response filed 16 February 2010 that "the filing date of Lewis postdates the priority date of the present application" and that "the priority document of Lewis ... [...] ... is lacking much of the disclosure of Lewis ... [and] ... fails to teach or suggest many elements recited in the claims," Examiner respectfully disagrees. Firstly, Examiner notes that Applicant fails to specify precisely what features or "elements recited in the claims" are missing in the priority document of Lewis. Secondly, as per arguments relating to discrepancies between the applied Lewis reference and the parent application of the Lewis reference (09/523,569), Examiner notes that although the diagrams are not labeled identically to the applied Pre-Grant Publication, and although the diagrams are not identical, nevertheless Examiner interprets the subject matter, to teach

Applicant's limitations. For example, numerous figures, such as Figures 4A-4E of the parent application of Lewis show examples of a graphical interface which simultaneously displays a graphical representation of anatomical features (401 , 410) and a set of controls (404, 412) relating to the plurality of medical conditions. In addition, descriptive text further elucidates the Lewis parent application (for example, see the Lewis parent application; page 4, lines 11-21, page 7, lines 24-30, page 15, lines 11-32, paragraph bridging pages 15-16, paragraph bridging pages 23-24, paragraph bridging pages 25-26, page 29, lines 3-21, and Figure 6 flow chart). Throughout the text, the parent application demonstrates interactively drilling down through anatomical features displayed on a user interface. Therefore, the Examiner respectfully disagrees with Applicants' interpretation of the teachings of the Lewis parent application, and interprets the Lewis reference to show teachings where applied. Furthermore, Examiner notes that it is the teachings of the combined, applied art, Lewis and Medigate, that must be considered when evaluating the 35 USC § 103 rejections.

At pages 8-10 of the 16 February 2010 response, Applicant analyzes the applied references separately and argues each of the references individually.

In response to Applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *in re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In addition, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly

suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

As per Applicant's arguments on page 10 of the response filed 16 February 2010 regarding "the Advisory Action," Examiner assumes that Applicant is referring to an advisory office action dated 28 January 2008 which was in response to claims filed 10 September 2007. Examiner respectfully notes that these claims differ from the present claims and, moreover, were rejected under 35 U.S.C. 102(c) as being anticipated by Lewis. In contrast, the current claims were rejected under 35 U.S.C. 103(a) as being unpatentable over Lewis and Medigate. Examiner again notes that it is the teachings of the combined, applied art, Lewis and Medigate, that must be considered when evaluating the 35 USC § 103 rejections. Moreover, Examiner submits that it was the Medigate reference (Examiner interprets Applicant's arguments regarding "Yoder" to refer to the Medigate reference), and not the Lewis reference, that was applied to teach the argued limitation: "the second graphical representation of anatomical features and the first set of controls displayed simultaneously without at least partially obstructing each other" (Medigate; Figure 2, page 332).

As per Applicant's arguments in the paragraph bridging pages 10-11 of the response filed 16 February 2010 that "[n]either Lewis nor Yoder [Examiner interprets 'Yoder' to refer to the Medigate reference] disclose a tri-state control," Examiner respectfully notes that this argument has been addressed earlier in this Office Action.

Furthermore, Examiner notes that although Medigate does not explicitly teach that the controls includes a tri-state control configured to indicate “present, not-present, or not entered,” this difference is only found in the non-functional data describing a control. The data identifying the control does not functionally relate to the substrate of the method. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see Cf. In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to label the controls in Medigate in any desired manner since merely labeling the data differently from that in the prior art would have been obvious matter of design choice. *See In re Kuhle*, 526 F.2d 553, 555, 188 USPQ 7, 9 (CCPA 1975).

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant’s disclosure.
7. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

8. Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks**

**Washington D.C. 20231**

or faxed to: **(571) 273-8300.**

For formal communications, please mark "EXPEDITED PROCEDURE".

For informal or draft communications, please label  
"PROPOSED" or "DRAFT" on the front page of the  
communication and do NOT sign the communication.

After Final communications should be labeled "Box AF."

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (571) 272-6774. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

10. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry O'Connor can be reached on (571) 272-6787. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or (571) 272-1000.

/N. A. P./  
Examiner, Art Unit 3686  
June 3, 2010

/Gerald J. O'Connor/  
Supervisory Patent Examiner  
Group Art Unit 3686